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AUS920030962US1 (IBM2852000)

PATENT APPLICATION  
SERIAL NO. 10/765,777

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Craig William Fellenstein, et al. §  
Serial Number: 10/765,777 §  
Filed: 01/27/2004 §  
For: SYSTEM AND METHOD FOR §  
AUTONOMIC PERFORMANCE §  
ENHANCEMENT OF STORAGE MEDIA §

Confirmation No.: 2482

Group Art Unit: 2166

Examiner: Navneet K. Ahluwalia

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Commissioner for Patents  
P.O. Box 1450  
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CERTIFICATE OF EFS-WEB TRANSMISSION

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on: January 6, 2009

/Bradley D. Ellis/  
Bradley D. Ellis

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

**REMARKS**

Applicants respectfully request review of the final rejection in this case for the following reasons. The Examiner has omitted several essential elements needed for a *prima facie* rejection. In particular, the Examiner's citations to the references are insufficient to support a determination of obviousness as required by law.

As stated in the MPEP: "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." and "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142. To make a *prima facie* case, the Examiner must perform certain established inquiries: "Obviousness is a question of law based on underlying factual inquiries." M.P.E.P. §2141(II). These factual inquiries include determining the scope and content of the prior art, "Ascertaining the differences between the claimed invention and the prior art;" and "Resolving the level of ordinary skill in the pertinent art." M.P.E.P. §2141(II)(citing *Graham v. John Deere Co.*, 383 U.S. 1, at 17-18, 148 USPQ 459, at 467 (1966)).

These factual inquiries required to establish a *prima facie* case are not optional: "Office personnel fulfill the critical role of factfinder when resolving the Graham inquiries . . . When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied." M.P.E.P. §2141(II)(emphasis added). Thus, the Examiner *must* make three factual inquiries in order to support a proper Section 103 rejection. Without these factual inquiries, the Section 103 rejection cannot stand: "Factual findings made by Office personnel are the necessary underpinnings to establish obviousness." M.P.E.P. §2141(II)(emphasis added).

The Examiner's rejections in this case fail to establish the scope and content of the prior art, fail to ascertain the differences between the claimed invention and the prior art, and fail to resolve the level of ordinary skill in the pertinent art. More particularly, the Examiner's rejections in this case amount to a mere recitation of the claim elements and a citation to one of the references, without supporting analysis, and in many cases, where the citation is insufficient on its face.

For example, regarding Claim 8, the Examiner asserts that Jochemsen teaches, "determining if the computer system is idle [sic] if the computer system is not idle, sleeping for an interval."

Final Action, Page 7 (*citing* Jochemsen, col. 1, lines 49-58). The cited passage reads, in full:

When a delete operation is necessary, it is desirable permanently to delete the minimum number of files so that (a) at least the required amount of free space is created; and (b) defragmentation and free-space defragmentation are optimized.

It is an aim of preferred embodiments of the present invention to provide a method, system and corresponding computer program product for reducing fragmentation of a digital storage device.

Jochemsen, col. 1, lines 49-58. As shown, the cited passage does not come anywhere close to teaching any determination of whether the computer system is idle. Nevertheless, the above citation is the entirety of the Examiner's argument, analysis, and fact-finding regarding this element. Applicants respectfully submit that a citation to a wholly inapposite passage of a reference cannot suffice as a *prima facie* case.

Furthermore, the Examiner later states "Jochemsen does not explicitly disclose as it is silent about the system operating when idle." Final Action, Page 7. Applicants respectfully note that "the system operating when idle" is not a Claim element, and does not imply or suggest "determining if the computer system is idle," as recited in the Claim. Nevertheless, the Examiner offers Carlson as purportedly teaching "the system working at all times and explicitly discloses about the idle system." Final Action, Page 7 (*citing* Carlson, paragraphs [0026]-[0027]). But neither does the

Carlson reference, in the cited passage or elsewhere, teach or suggest “determining if the computer system is idle,” as recited in the Claim. As such, for this reason alone, the Examiner’s proposed combination cannot support *prima facie* obviousness.

And “determining if the computer system is idle” is not the only element missing from the Examiner’s proposed combination, nor is Claim 8 the only Claim for which the Examiner has failed to provide a proper *prima facie* case. For example, nowhere does Jochemsen/Carlson teach “determining if defragmentation is complete [sic] if defragmentation is complete, deleting the location of the fragmented file clusters in the storage medium” as the Examiner alleges. Final Action, Page 9 (*citing* Jochemsen, col. 1, lines 49-53). As shown above, the cited reference does not teach anything close to “determining if defragmentation is complete.” *See supra*; Jochemsen, col. 1, lines 49-53. Applicant respectfully submits that nowhere else does Jochemsen teach “determining if defragmentation is complete.” Nor does the Examiner anywhere suggest that Carlson supplies this missing element.

As stated in the MPEP, “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. §2142. Applicants respectfully submit that a plain recitation of claim elements, with references to inapposite citations, cannot be fairly considered a “clear articulation” as required by the MPEP. “[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” M.P.E.P. §2142 (*quoting In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Applicants respectfully submit that the Examiner has not met this burden.

Accordingly, Applicant respectfully submits that the Examiner has failed to produce a proper *prima facie* case by failing to conduct the required Graham inquiries for each and every

Claim under examination. As such, Applicant respectfully submits that the Section 103 rejections are wholly unsupported and therefore are improper.

Applicants have now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request full allowance of Claims 1, 3-5, 7-8, 10-11, and 13.

Applicants hereby authorize the Director to charge the required fee for the filing of a Notice of Appeal to Deposit Account No. 09-0447 of IBM Corporation. Applicants do not believe that any other fees are due; however, in the event that any other fees are due, the Director is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account No. 09-0447 of IBM Corporation.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

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